

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of

Docket No.: P30247

Jean-Michel DEFERT

Confirmation No.: 2161

Serial No.: 10/597,508

Group Art Unit: No. 3673

Filed: November 3, 2006

Examiner: A. M. Merlino

For: ELECTROMAGNETIC LOCK PROVIDED WITH A SLIDING BOLT FOR
A SWINGING-TYPE DOOR

REQUEST FOR PRE-APPEAL BRIEF REVIEW

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Mail Stop **AF**
Randolph Building
401 Dulany Street
Alexandria, VA 22314
Sir:

This request is being filed concurrently with a Notice of Appeal and is responsive to the Final Official Action of June 24, 2010. Reconsideration and withdrawal of the rejection(s) under 35 U.S.C. § 112, 2nd paragraph, of claims 5-32 is requested in view of the following remarks.

Examiner's Assertion

In the Final Office Action, the Examiner objected to claim 5 for an alleged informality and has required that Applicant add features of dependent claim 32 to claim 5 to address the informality.

Applicant's Response

While Applicant acknowledges that the noted objection need not be resolved during the Pre-Appeal process, because resolution in Applicant's favor (should such occur) of the rejection addressed in this Pre-Appeal would render the objection to claim 5 as the only obstacle to

allowance (note that claims 5-32 have been indicated to contain allowable subject matter), it is respectfully requested that this issue be addressed, if possible, during Pre-Appeal.

In this regard, it is Applicant's contention that the Examiner has not properly objected to claim 5. That is, the Examiner has not positively identified the "informality" that requires Applicant's attention. Instead, the Examiner is requiring a narrowing of the scope of the claims without any justification to do so.

As set forth in MPEP § 706.01, which contrasts objections from rejections, "[i]f the form of the claim (as distinguished from its substance) is improper, an 'objection' is made." Applicant asserts that the Examiner's pending objection fails to identify any improper form in claim 5 to support this objection. Moreover, as the Examiner suggested resolution to this "objection" is to narrow the scope of the claim, i.e., to address the substance, Applicant submits this objection is wholly improper and should be withdrawn.

Finally, Applicant submits that there is no legal basis for requiring the narrowing of claim 5 to include subject matter recited in claim 32. To the extent that the Examiner believes that claim 5 to be lacking with regard to form, the Examiner is invited to set forth a proper objection to the claims, which heretofore has not been done. Therefore, reconsideration and withdrawal of this objection is requested.

Examiner's Assertion

In the Final Office Action, the Examiner rejected claim 5 as being indefinite apparently because it recites alternative limitations in an unclear manner.

Applicant's Response

Applicant respectfully disagrees and submits that the last "wherein" clause in claim 5 is not unclear. The noted clause is as follows:

wherein one of:

the movable plate moves the retractable sliding bolt to the protruding position;

and

the electromagnet core is arranged between a front side of the movable plate and a free end of the retractable sliding bolt.

It is clear that the two phrases indented underneath the “one of” language are intended to be alternatives. Moreover, it is submitted that alternative limitations (which are clearly recited in the last “wherein” clause) are not *per se* improper. The Examiner’s attention is again directed to page 5 of the non-precedential Board decision *Ex parte HARDING* which specifically noted that alternative limitations were not *per se* indefinite. (“There is nothing inherently indefinite about the use of alternative expressions: the claims can be met by any one of the alternative limitations.”).

Examiner’s Assertion

In the Final Office Action, the Examiner rejected claims 5, 12 and 17 as being indefinite because they are allegedly incomplete for omitting essential elements under MPEP 2172.01.

Applicant’s Response

Applicant respectfully disagrees and submits that the Examiner’s reliance on MPEP 2172.01 is misplaced. Respectfully, Applicant is not *per se* required by MPEP 2172.01 (or Section 112, 2nd paragraph) to limit the invention to any particular cooperative relationship between the recited structural features.

In particular, Applicant respectfully submits the Examiner has misread MPEP 2172.01, which indicates that when it is indicated “by applicant” in the specification that certain features are essential to the invention, such features must be recited in the claims.

The Examiner has identified no features indicated "by Applicant" to be essential to the invention in the specification, which are not recited in the claims. In fact, Applicant has not described in the specification any devices as critical or essential to the invention, and certainly none of the elements alleged by the Examiner to be essential. Moreover, the Examiner has respectfully failed to identify any portion of the specification which supports the Examiner's position that such devices are asserted to be critical. Accordingly, the Examiner's reliance on MPEP 2172.01 is respectfully misplaced and this rejection is believed to be improper and should be withdrawn.

Applicant also directs the Examiner's attention to page 8 of the previously submitted non-precedential Board decision *Ex parte ROTHENBERG et al.* which supports Applicant's reading of MPEP 2172.01. There the Board agreed with Applicant that the rejection was improper because "the elements set out by the examiner were not defined in their specification as essential elements of the invention." Accordingly, withdrawal of the pending rejection is respectfully requested.

Examiner's Assertion

In the Final Office Action, the Examiner rejected claim 26 as being indefinite apparently because there is no language in claim 26 describing how the retractable sliding bolt can be prevented from moving back away from a protruding position.

Applicant's Response

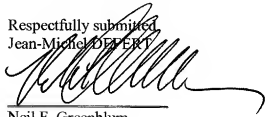
Applicant respectfully disagrees with this basis of rejection and submits that the requirement that the claims be read in light of the specification and drawings support Applicant's position that the claims are definite.

The Examiner has set forth no other legal basis for requiring Applicant to limit the invention in the suggested manner. Section 112, 2nd paragraph, does not require Applicant to specify the relationship between all of the parts of the lock shown in Fig. 1. Applicant submits that the requirement that the claims be interpreted in light of the specification provides sufficient basis for the claims being definite. The Examiner is reminded that Applicant is entitled to the broadest reasonable interpretation permitted by the prior art, and that one of ordinary skill in the art, having read the specification, would understand that which is claimed.

The language indicating that the retractable sliding bolt can move back away from a protruding position is clearly shown in Figs. 1 and 3 - with Fig. 1 showing the protruding position of bolt 3 and Fig. 3 showing a position of the bolt 3 after it moves back away from the position of Fig. 1. Respectfully, using the electromagnet core 6 (which magnetically attracts plate 4 when energized) to maintain the position of Fig. 1 and prevent the bolt 3 from moving back to the position shown in Fig. 3 would be readily apparent to one of ordinary skill in the art from a fair reading of Figs. 1 and 3 and the relevant description thereof in the specification.

There is no requirement that Applicant recite in the claims a fully functioning invention. Applicant can instead recite sufficient features of the invention which define the scope of desired patent protection and which is sufficient to define the invention over the prior art.

Respectfully submitted,
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